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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,659	11/13/2003	Francis Bourrieres	N48.2I-11373-US01	2594
490 7590 10/15/2007 VIDAS, ARRETT & STEINKRAUS, P.A. SUITE 400, 6640 SHADY OAK ROAD EDEN PRAIRIE, MN 55344			EXAMINER JOHNS, CHRISTOPHER C	
			ART UNIT 4172	PAPER NUMBER
			MAIL DATE 10/15/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/712,659

Applicant(s)

BOURRIERES ET AL.

Examiner

Christopher C. Johns

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/22/03
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 recites an identifier that is "non-reproducible". This assertion is absolute and unfounded in the specification. Furthermore, if importing the "non-reproducible" assertion from inventors' previous application (10/182967), note that the identification in that case was rejected for the same reason.

Claim 8 rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 6 and 7 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are drawn to an "operator" performing a

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number of actions in the method. This operator, in this case, is a human being. This would result in a potentially non-reproducible method. As an example, consider two humans who are tasked to examine the identifiers. Every person's eyesight differs from another person's eyesight. If identical data was given to two different people to examine, there is the possibility that the authentication result would differ (resulting in a non-repeatable method).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 8 rejected under 35 U.S.C. 102(b) as being clearly anticipated by United Kingdom Patent 2,304,077 (hereafter referred to as Farrall).

#### **As per claim 1:**

Farrall describes a security device that has a plurality of reflective elements, placed in a non-reproducible fashion so as to create a "signature" that cannot be practically be duplicated (cf. page 1, paragraph 5) which attaches to a device such as a credit card (cf. page 2, paragraph 6 – "the presence of shiny metallic particles randomly distributed in three dimensions throughout the very fabric of the device which is conveniently illustrated in the form of a card") ("*a unique and non-reproducible identifier is physically integrated in the medium comprising the number*"). The preferred embodiment in System II (page 9) details usage as a credit card system:

The purpose of this system is to identify the card offered and to compare its Crystal signature with the cardholder details held on file...the card's signature is first established prior to issue and recorded on the system (1: "*this identifier*

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*constitutes an unforgeable link between the number located on the medium and information stored under the same number in the database, said stored information comprises at least one representation of the identifier comprising an image and/or a digital signature of the unique and non-reproducible identifier")*

The embodiment in System II goes on to say the following:

*...the signature derived from the card would be compared with the PIN code to confirm whether the card was the original or a forgery (a forgery would generate the wrong electronic signature) (1: "the link authentication is performed by means of a comparison between a representation of the identifier stored in said database and the identifier located on the medium, and if there is agreement, the transaction is authorized").*

**As per claims 2, 3, 4:**

As is inherent to most credit cards, the "number" (meaning the credit card number) is recorded using a magnetic strip (2: *"number is recorded on the medium by means of a magnetic strip or tape"*). On other credit cards, the examiner takes Official Notice that some credit cards are known to have said number stored in a bar code fashion (Lord and Taylor, a department store, offers a charge card which contains a barcode instead of a magnetic strip) (3: *"number is recorded in the medium by means of a linear bar code or a two-dimensional code"*). Still other cards are "smart cards", which inherently store that number (in addition to other numbers) on an electronic chip embedded in the card (4: *"number is recorded on the medium by means of an electronic chip or radio frequency chip"*).

**As per claim 8:**

As described in the System II embodiment, the Automatic Teller machine would perform the authentication. As above: "the signature derived from the card would be compared with the PIN code to confirm whether the card was the original or a forgery (a forgery would generate the wrong electronic signature). Once the validation checks were completed the transaction could continue in the normal way" (8: *"the authentication of the unforgeable link authorizing the transaction is performed automatically. When the operators place a call to the database to the number recorded on the medium, the unit captures the identifier and then the image of this identifier is transmitted to the remote database, a computation of the signature corresponding to the image received by the database is performed and compared to that stored in said database. If there is agreement, authentication of the link exists and the transaction is authorized"*).

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Claims 1 and 5-7 rejected under 35 U.S.C. 102(b) as being anticipated by United Kingdom Patent 2,324,065 (hereafter referred to as Slater et al).

**As per claim 1:**

Slater et al covers an "identification code for banknotes or credit cards comprising a pattern of random beads" (cf. Abstract Title). Said code is comprised of a "plastic matrix having embedded therein randomly-positioned visually distinguishable beads" (cf. Abstract). Said matrix's aim is to be "very difficult, to the extent of being practically impossible, to reproduce the label" (1: *"a unique and non-reproducible identifier is physically integrated in the medium comprising the number"*), "...therefore to provide an uncounterfeitable unique label" (1: *"this identifier constitutes an unforgeable link between the number located on the medium and information stored under the same number in the database"*) (page 1, lines 24-28).

The Abstract further states that the label "can be read and stored in a database as an identifier of the banknote [or credit card]" – using this code as a precondition for acceptance of the banknote or credit card (1: *"said stored information comprises at least one representation of the identifier comprising an image and/or a digital signature of the unique and non-reproducible identifier, the link authentication is performed by means of a comparison between a representation of the identifier stored in said database and the identifier located on the medium, and if there is agreement, the transaction is authorized"*).

**As per claim 5:**

On page 2, lines 26-29, it is disclosed that "bubbles could be used" instead of the bead system described above (5: *"a volume-based identifier in which are contained bubbles of random size, shape, and arrangement"*).

**As per claims 6 and 7:**

On page 4, lines 13-21, it is disclosed that the "code is stored in a database so that it is always possible to check the identity of the object by reading the label attached to it and checking it with the database". Furthermore, the "object could also be provided with a serial number against which the identification code could be checked..." – which can easily be checked by a human operator (6: *"authentication of the unforgable link authorizing the transaction is performed in a visual manner by an operator"*, 7: *"an image stored in said database is sent back to the operator and a visual examination is performed by comparing said image appearing directly on the terminal monitor or printed on the receipt of the printer, with the real, unique, and non-reproducible identifier integrated in the medium comprising the number"*).

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### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher C. Johns whose telephone number is 571-270-3462. The examiner can normally be reached on Monday-Thursday, 7:30-5, Alternate Fridays, 7:30-4.

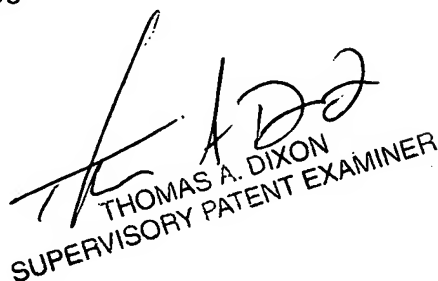
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



CCJ

Christopher Johns  
Examiner  
Art Unit 3609



THOMAS A. DIXON  
SUPERVISORY PATENT EXAMINER